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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/680,902	10/06/2000	Joaquin Feria	10022/46	2958
28164	7590	04/05/2004	EXAMINER	
ACCENTURE CHICAGO 28164 BRINKS HOFER GILSON & LIONE P O BOX 10395 CHICAGO, IL 60610			SHAFFER, ERIC T	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 04/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/680,902

Applicant(s)

FERIA ET AL.

Examiner

Eric T. Shaffer

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MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the amendments filed January 13, 2004.

Claim Objections

2. Claim 16 is objected to because of the following informalities: Claim 16 is dependent on claim 14, which has been cancelled. Appropriate correction is required.

Summary of Instant Office Action

3. Applicant's arguments, filed January 13, 2004, concerning claims 1 – 16 in the Office Action mailed September 10, 2003, have been considered and are deemed persuasive.

Claims 14 and 15 have been cancelled by the applicant and no new claims have been added. Claim 6 has been amended.

All of the rejections in the Office Action mailed out on September 10, 2003 have been Withdrawn and replaced with the rejections based on new art.

4. ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 1 – 13 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the white paper “TCO Discovery Audit for XYZ Publishing Company”, published in June 1999 in view of the paper “TCO Analyst”, published in 1997.

As per claims 1 and 7, TCO Discovery Audit teaches a method for determining and analyzing the cost for supporting each user of an information technology system, the method comprising:

obtaining base costs (“labour costs”, page 4; “hardware and software”, page 5; “capital”, page 4; “installing”, page 1), wherein base cost is defined in the applicant’s specifications as labor costs, hardware and software costs, capital costs and installation costs;

obtaining ongoing direct costs (“Direct budgeted costs”, page 4);

obtaining ongoing indirect costs (“Indirect unbudgeted costs”, page 4);

TCO Discovery Audit does not specifically teach obtaining, gathering and inputting information said cost information. A reason for gathering, obtaining and inputting information would be useful would be to allow the user to enter new data instead of relying on old data that is in the system.

TCO Analyst contains an interface that allows the user to input data (“this prototype illustrates a common interface to all the Gartner Group TCO models”, page 21, figure 19), where a common interface, such as the graphical user interface taught by figure 19, is an old and well known way of inputting data. A reason that the TCO Discovery Audit article and the TCO Analyst article are analogous is both articles teach the total cost of ownership (TCO) and teach the same list of direct costs, indirect costs and base costs, and both of these references as well as the applicant’s invention contain the phrase “Total Cost of Ownership” or TCO within

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their respective titles. A reason for gathering, obtaining and inputting information would be useful would be to allow the user to enter new data instead of relying on old data that is in the system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the TCO Analyst interface into the invention taught by the TCO Discovery Audit article because such an interface would allow a user to directly enter data. Without the ability to enter data, the TCO Discovery Audit invention would be very difficult to use. Incorporating an input device would make the invention much easier to use and therefore would allow the invention to be useable by a larger body of users, which would increase the potential market for such a device.

6. As per claims 2 and 8, TCO Discovery Audit teaches a method wherein said base costs include installation costs (“installing”, page 1), acquisition costs (“capital, fees, and labour costs spent”), where acquisition costs are defined as capital costs in the applicant’s specifications.

TCO Discovery Audit teaches costs but does not teach design costs. A reason why design costs would be useful to include design costs is that design is a major cost component of creating an improved system.

TCO Analyst teaches design elements (“designed improvement TCO methodology – Determined which new TCO elements were important to incorporate into architecture; create high-level sketches of interaction of key elements”, page 2). A reason that the TCO Discovery Audit article and the TCO Analyst article are analogous is both articles teach the total cost of

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ownership (TCO) and teach the same list of direct costs, indirect costs and base costs, and both of these references as well as the applicant's invention contain the phrase "Total Cost of Ownership" or TCO within their respective titles. A reason why design costs would be useful to include design costs is that design is a major cost component of creating an improved system.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the TCO Analyst interface into the invention taught by the TCO Discovery Audit article because improving a system requires some type of design or redesign work. As the costs for employing designers is an expensive element of IT development, it would be useful to incorporate this cost in order to improve the accuracy of the PC TCO system.

7. As per claims 3 and 9, TCO Discovery Audit teaches a method wherein said ongoing direct costs include:

production control costs and monitoring costs ("the overhead of managing the process", page 1), wherein a process is managed by production control and by monitoring costs;

changes in upgrade costs ("the budgeted cost of distributing and updating software applications", page 1), wherein updating software is updating software;

support costs ("installing, managing and supporting", page 1);

operational costs ("Operations", page 5).

TCO Discovery Audit does not teach security management and failure control costs. A reason this would be useful is that in many high security systems, security is a high cost of operating a PC.

TCO Analyst teaches security management (“Security, Security Administration, Security/Virus”, page 8, figure 5) and failure control costs (“backup and recovery, virus protection”, page 16, figure 14), which are the costs that result when a security lapse occurs and a backup must occur to prevent a catastrophic system failure. A reason that the TCO Discovery Audit paper and the TCO Analyst article are analogous is that both references discuss total cost of ownership (TCO) and teach a list of direct costs, indirect costs and base costs. Finally, both of these references as well as the applicant’s invention contain the phrase “Total Cost of Ownership” within their respective titles. A reason this would be useful is that in many high security systems, security is a high cost of operating a PC.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate security aspects of the TCO Analyst interface into the invention taught by the TCO article because security, security administration and virus security are potentially an expensive component of PC cost management. Incorporating the cost of security would be important for PC’s in high security areas as well as PC’s that work through the Internet and have the accompanying virus firewall security software.

8. As per claims 4 and 10, TCO Discovery Audit teaches a method of claim 1, wherein said ongoing indirect costs (“Indirect costs”, page 5) include end-user costs (“End User Operations”, page 5) and downtime costs (“Downtime”, page 5).

9. As per claim 5, TCO Discovery Audit teaches a method of claim 1, wherein at least one of said costs correspond to at least one information technology function and the cost for each user is broken down according to said information technology function (“the total cost of purchasing, managing and using PCs in the distributed computing environment can approach

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(\$10,000) for every user”, page 1), wherein supporting PC users is one of the many functions supported by the IS department.

10. As per claim 6, TCO Discovery Audit teaches a method for performing budgeting that incorporates activity based costing and analyzes the costs associated with supporting an information technology system, the method comprising:

obtaining cost information (“The GartnerGroup TCO model utilizes two major categories to organize costs:”, Direct budgeted costs and Indirect unbudgeted costs”, page 4);

obtaining system characteristics (“Technology Quantity and Type: Servers, Client-Computers-Desktop, Client Computers-Mobile, Peripherals, Network”, page 3);

calculating appraisal metrics based on said cost information and said system characteristics (“Target-Actual”, page 4), where Target-Actual is calculated by subtracting Target from Actual;

comparing said appraisal metrics with established benchmarks (“Target-Actual”, page 4), where Target-Actual is the result of comparing and subtracting Target from Actual;

providing the appraisal metrics (“Actual TCO by Category”, pages 6; Typical TCO by Category”, page 7; “Target TCO by Category”, page 8) and cost information (“TCO Analysis Overview”, page 5; “Hardware and Software Costs”, page 9) in separate reports or tables for the corresponding organizational function categories.

TCO Discovery Audit teaches appraisal metrics and cost information, but does not teach application to information technology categories. A general reason that it would useful to

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include information technology categories into the metric and cost categories would be determine which areas could be most profitably and effectively improved.

TCO Analyst teaches numerous information technology organizational function categories, and includes these functional categories:

service management, (“Service / PM”, page 5), wherein PM means Performance Management;

systems management (“NOS Performance Management”, page 5), wherein NOS means Network Operating System;

service planning (“Planning”, page 5) and change management (“Adds, Moves and Changes”, page 5).

A reason that the TCO Discovery Audit article and the TCO Analyst article are analogous is that both teach the total cost of ownership (TCO) and teach the same list of direct costs, indirect costs and base costs, and both of these references as well as the applicant’s invention contain the phrase “Total Cost of Ownership” or TCO within their respective titles. A general reason that it would useful to include information technology categories into the metric and cost categories would be determine which areas could be most profitably and effectively improved.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the TCO Analyst invention taught by the TCO Discovery Audit article because such a combination would allow a user to analyze cost data and performance metrics specifically by information technology functional area, which would allow process

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improvements to be directed at areas that improvements were needed or would be most profitable to be changed.

11. As per claims 11 and 12, TCO Discovery Audit teaches a method of claim 6, wherein said system characteristics and appraisal metrics include:

financial characteristics (“Total TCO as a Percentage of Annual Revenue”, page 5), wherein Revenue is a financial characteristic;

operating and efficiency characteristics (“performance improvements”, page 2), wherein improving performance is a characteristic of operating efficiency;

infrastructure and evolution characteristics (“infrastructure improvements”, page 2).

12. As per claim 13, TCO Discovery Audit teaches a method of claim 12, wherein said financial perspective metrics are based on said financial characteristics and said cost information (“Total Direct Costs as a Percentage of Annual Revenue”, page 5).

13. As per claim 16, TCO Discovery Audit teaches a method of claim 14, wherein said metrics are used to determine cost improvement opportunities through best practices implementation for said category wherein the cost savings are from improvement in the practice factors (“a comprehensive report is produced that compares Actual TCO to a Typical and Target TCO using extensive research data and we show you exactly where cost savings and service improvements can be made”, page 1), where Actual, Target and Typical are metrics.

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Response to Amendments

14. Applicant's arguments filed January 30, 2004 have been fully considered and are persuasive.

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Conclusion

15. Applicant's amendment necessitates the new ground(s) of rejection presented in this Office Action. THIS ACTION IS MADE FINAL. See MPEM 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The prior art made record of and not relied upon is considered pertinent to applicant's disclosure.

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of final action.

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Eric Shaffer whose telephone number is (703) 305-5283. The Examiner can normally be reached on Monday-Friday, 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax number for the organization is (703) 305-0040/308-6306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

Eric Shaffer

March 26, 2004


TARIQ R. HAFIZ
SUPERVISORY PATENT EXAMINER
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